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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/637,388

**Applicant(s)**

RILEY ET AL.

**Examiner**

GREGORY J. VAUGHN

**Art Unit**

2178

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 70, 71, 73-75, 77-79 and 81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70, 71, 73-75, 77-79 and 81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Action Background***

1. This action is responsive to the submission of the Appeal Brief filed on 4/16/2007, and the amendment for the Appeal Brief filed 4/16/2007.
2. Arguments and remarks presented in the Appeal Brief are persuasive, and therefore the finality of the office action dated 8/10/2006 has been withdrawn.
3. Claims 70, 71, 73-75, 77-79 and 81 are pending in the case; claims 70, 74 and 78 are independent claims.
4. The examiner's rejection of claims 70, 71, 74, 75, 78 and 79, rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. US Patent publication 2003/0196164, as described in the office action dated 8/10/2006 is withdrawn in view of the arguments presented in the Appeal Brief filed 4/16/2007, however, new grounds of rejection are made, as described below.
5. The examiner's rejection of claims 73, 77 and 81, rejected under 35 USC 103(a) as being unpatentable over Gupta in view of Bohlen et al., "The effect of Learning Style and Method of Instruction on the Achievement, Efficiency and Satisfaction of End-Users Learning Computer Software", as described in the office action dated 8/10/2006 is withdrawn in view of the arguments presented in the Appeal Brief filed 4/16/2007, however, new grounds of rejection are made, as described below.

**Claim Rejections - 35 USC § 112**

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."*

7. Claims 73, 77 and 81 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
8. **Regarding claim 73**, the amendment filed 6/15/2005 adds the following limitations: *"prohibiting access to the at least one document after completion of the interactive learning course"*. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitation. Applicant is required to cancel the new matter in response to this office action.
9. **Regarding claims 77 and 81**, the claims contain the same new matter as described above in relation to claim 73, and are rejected using the same rationale.

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10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

11. Claims 73, 77 and 81 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. The term "*prohibiting access to the at least one document*" in claims 73, 77 and 81 is a relative term, which render the claims indefinite. The term "*prohibiting access to the at least one document*" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Furthermore, the originally filed disclosure fails to describe or suggest "*prohibiting access to the at least one document*" (see the 35 USC 112 first paragraph rejection stated above).

**Claim Rejections - 35 USC § 103**

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

14. Claims 70-72, 74-74 and 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. US Patent publication 2003/0196164, filed 9/15/1999, published 10/16/2003 (hereinafter Gupta) in view of Blumer et al., US Patent 5,732,219, filed 3/17/1995, patented 3/24/1998 (hereinafter Blumer).

15. **Regarding independent claim 70**, Gupta discloses electronic note taking by a user during an interactive learning course. Gupta discloses an interactive learning system with students and instructors. Gupta recites: *"These annotations typically correspond to a particular temporal location in the multimedia presentation and can provide a replacement for much of the "in-person" interaction and "classroom discussion" that is lost when the presentation is not made "in-person" or "live". As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can continue, allowing a "classroom discussion" to occur via these*

*annotations*" (page 1, paragraph 6). See also Figure 3, where a user interface is shown at reference sign 152.

Gupta discloses a document annotation system. Gupta recites: "*According to one aspect of the invention, multiple annotations are maintained together as an annotations collection corresponding to particular multimedia content*" (page 1, paragraph 12), where Gupta defines the multimedia content as: "*The data can be as simple as ASCII text or as complex as HTML code which can include text having different fonts and type styles, graphics including wallpaper, motion video images, audio, and links to other multimedia documents*" (page 5, paragraph 66).

Gupta disclose an annotation field associated with a document. Gupta recites: "*FIG. 5 shows an exemplary structure for an annotation entry 180 that is maintained by annotation server 10 in annotation meta data store 18 of FIG. 3. In the illustrated example, the annotation entry 180 includes an author field 182, a time range field 184, a time units field 186, a creation time field 188, a title field 190, a content field 192*" (page 5, paragraph 59). Gupta discloses receiving the entry of notes form a user in the annotation field in figure 8 at reference sign 276.

Gupta discloses storing the annotations in memory and associating them with a document. Gupta recites: "*annotations typically correspond to a particular multimedia presentation. Since each of the different versions of the multimedia content is a different multimedia presentation, typical annotations correspond to only one of these presentations*" (page 1, paragraph 8).

Gupta discloses providing access to the document and notes during the interactive learning course. Gupta recites: *"As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can continue, allowing a "classroom discussion" to occur via these annotations"* (page 1, paragraph 6).

Gupta discloses providing access to the entered notes after the completion of the interactive learning course. Gupta recites: *"Additionally, some systems allow a user to select a particular one of these annotations and begin playback of the presentation starting at approximately the point in the presentation to which the annotation corresponds"* (page 1, paragraph 6).

Gupta discloses limiting access to the entered notes. Gupta recites: *"According to one embodiment of the invention, annotation server 10 of FIG. 3 supports read and write access controls, allowing the creator of the set to identify which users are able to read and/or write to the annotation set. In this embodiment, only those sets for which the user has write access can be entered as set identifier 272"* (page 7, paragraph 90). Gupta's use of controls allows limiting the access to the entered notes to various users, however Gupta fails to explicitly disclose limiting access to only the user who entered the notes. Blumer discloses limiting access to user entered information to the user only. Blumer recites: *"Another advantage of this system is that the authoring tool uses the basic authentication procedures provided by the HTTP protocol and the Web server software. Access to files on the server*



*machine may be limited to service authors with a validated user name and password"* (column 11, lines 35-39).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to provide an author exclusive access to the author's work, as taught by Blumer, with the annotation system of Gupta, in order to provide: *"access control for each document object such that only specified users (with optional passwords) or groups of users are allowed access to the object"* (Blumer, column 4, lines 22-24).

16. **Regarding dependent claim 71**, Gupta discloses the note containing content contained in the document. Gupta recites: *"multimedia content is duplicated in the annotation"* (page 1, paragraph 9).
17. **Regarding claims 74 and 78**, the claims are directed toward a computer readable storage medium and server/system, respectively, for the method of claim 70, and are rejected with the same rationale.
18. **Regarding claims 75 and 79**, the claims are directed toward a computer readable storage medium and server/system, respectively, for the method of claim 71, and are rejected with the same rationale.
19. Claims 73, 77 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Blumer, in further view of Bohlen et al., "The effect of Learning Style and Method of Instruction on the Achievement,

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Efficiency and Satisfaction of End-Users Learning Computer Software"

Published on the Internet by ACM, 1993 (hereinafter "Bohlen").

20. **Regarding dependent claim 73**, Gupta and Blumer disclose a document based interactive computer based learning, as described above. Gupta discloses controlling access to the interactive learning annotations. Gupta recites: *"According to one embodiment of the invention, annotation server 10 of FIG. 3 supports read and write access controls ... to the annotation set"* (page 7, paragraph 90). Gupta fails to explicitly describe controls for the learning material. Bohlen discloses a study of the effectiveness of computer-based training (abstract, page 273), where a lecture course was compared to a computer based training method, wherein results were determined by test scores (page 277, second, third and last paragraphs). Bohlen discloses subject matter testing, and it is well known in the educational arts that testing is traditionally undertaken after completion of the learning course in a "closed book" environment, wherein access to the learning material is prohibited.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine prohibiting access to learning course material, as taught by Bolen, with the annotations control of learning course documents of Gupta, in order to effectively test learning course students as to the degree of effectiveness of the learning course.

21. **Regarding claims 77 and 81**, the claims are directed toward a computer readable storage medium and server/system, respectively, for the method of claim 73, and are rejected with the same rationale.

### ***Response to Arguments***

22. Applicant's arguments, see the Appeal Brief filed 1/16/2007 with respect to the rejection(s) of claim(s) 70, 71, 73-75, 77-79 and 81 been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made, as described above.
23. Regarding claims 73, 77 and 81, appellant argues that the Bohlen reference fails to teach subject matter testing (page 7, first paragraph to page 10 second paragraph, of the Appeal Brief filed 1/16/2007). However the examiner has relied upon Bohlen to teach student testing for computer oriented learning environments. It is well known that testing, in an educational environment, comes after completion of learning. It also well known that testing is done where the student is prohibited from accessing the learning materials. Appellant notes that not all testing is "closed-book" testing, and provides the "*Preparing for Open Books Exams*" non-patent literature (author and date unknown). The examiner concedes that "*open-book*" testing is at least as well known as "*closed-book*" testing. However, the usual meaning for the term "testing" is testing without assistance, or closed book testing. When assistance is allowed during the test, the term "*test*" is modified by in some

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way (for example: "*open-book*" testing, "*Open-source*" testing, "*open-note*" testing, and ex.).

24. Also regarding claims 73, 77 and 81, appellant argues that the examiner had no motivation to combine Gupta and Bohlen (page 11, last paragraph to page 12 second paragraph, of the Appeal Brief filed 1/16/2007). It should be noted that the references are analogous because they both are directed toward computer based learning.
25. Also regarding claims 73, 77 and 81, appellant argues that the 35 USC 112 first and second paragraph rejections (page 12, third paragraph to page 15 fourth paragraph, of the Appeal Brief filed 1/16/2007) are improper and point to original claim 16 for support. However, original claim 16 is directed toward storing user notes and has nothing to do with accessing the at least one document (i.e. the learning material). Appellant has erroneously indicated that the issue is related to the language "*prohibiting access*". However, the issue is "*prohibiting access to the at least one document*". The "*at least one document*" is the learning material. The specification fails to describe prohibiting access to the learning materials, therefore the rejection under 35 USC 112 first and second paragraph is proper.

***Conclusion***

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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March 20, 2008